

### **REMARKS**

This paper is responsive to an Office Action dated June 22, 2006. This paper is being filed within the three month statutory period for response and therefore no extension or extension fees are believed necessary.

In the present action, claims 1-14, 16-21, 23, 24, 59 and 60 stand rejected under 35 U.S.C. §103 as being allegedly unpatentable over the combination of the O'Leary, Sidles and Wiens references.

By way of background, during a telephonic interview held March 27, 2006, the Examiner and undersigned reached agreement that neither O'Leary or Sidles explicitly teaches communicating computer code to a user's computer for determining if a merchant website is a supported website. In the present action, the Examiner has added a third reference, namely the Wiens reference, to develop a three-reference obviousness combination that allegedly cures the stated deficiency. Specifically, in the present action, the Examiner states:

O'Leary and Sidles both fail to explicitly teach communicating determination code to the user's computer for determining if a merchant website is a supported website. Wiens teaches a method for automated ordering by a customer at a remote location to a vendor similar to that of O'Leary and Sidles. Furthermore, Wiens teaches communicating computer code to a user's computer from the remote vendor, the code containing pertinent vendor information, at column 7, lines 28-47.

Initially, it is respectfully submitted that the Examiner's three-reference combination is impermissible. A legal conclusion of obviousness requires that there be some suggestion, motivation or teaching in the prior art whereby the person of ordinary skill would have selected the components that the inventor selected and use them to make the new device. It is respectfully submitted that there is a complete absence of a showing of motivation in either Sidles or O'Leary to look to the Wiens reference to cure the admitted deficiency of those references, nor does Wiens contain such motivation. The mere fact that Wiens relates to order entry does not, of itself, supply the

motivation to utilize Wiens in either Sidles or O'Leary to provide the missing claim element of communicating determination computer code to the computer, the determination computer code configured to determine if a merchant website is a supported merchant website. Thus, initially, it is respectfully submitted that, in the absence of a showing of any motivation to combine O'Leary and Sidles with Wiens, the three-reference combination is improper and the rejections to claims 1-14, 16-21, 23, 24 and 59, which are all based on the three-reference combination, should be withdrawn.

Even assuming for the sake of argument, an assumption which is by no way admitted, that the three-reference combination were somehow proper, the teachings of the Wiens reference could still not form the basis of a proper §103 rejection, since Wiens does not in fact cure the recognized deficiencies of O'Leary and Sidles. Both O'Leary and Sidles fail to teach communicating determination code to the user's computer for determining if a merchant website is a supported website. Wiens teaches a system whereby a typical computer such as a personal computer has installed thereon custom software that enables the computer to communicate with a centrally located vendor computer to which a customer may connect via a customary communication medium, such as a modem through telephone lines, etc. Wiens, column 4, lines 25-30. Wiens teaches a system whereby computer code is provided to the user's computer to facilitate offline order entry so that a user may complete an automated order and only connect to the vendor's central computer to actually place the order after the order information has been entered offline. As stated in Wiens, at column 3, lines 37-41, the Wiens system allows users to compose their orders prior to calling the central computer thus minimizing telephone expenses. Thus, rather than disclosing a system such as that described in the above captioned presently pending application, Wiens describes a dedicated customer order environment whereby a user installs custom software to communicate with a predetermined vendor for placing orders in a manner that minimizes communication bandwidth through the use of pre-entered information being entered at the user's

computer prior to establishing a communication session with a known vendor computer. Thus, unlike the presently claimed limitation of communicating determination code to the user's computer for determining if a merchant website is supported, the Wiens system teaches an environment whereby the user already knows the identity of the vendor it intends to communicate with since the vendor is the entity that supplied the custom software required to facilitate offline order entry and communication with that specific vendor's customer order computer. Thus, it is respectfully submitted that in the system of Wiens, no determination code is contemplated, nor taught, nor suggested, since it is explicit in Wiens that the customer knows the vendor that it intends to connect to by virtue of having already completed much of the order entry task prior to establishing a communication session with the vendor computer. Thus no determination of whether a website is a supported website needs to be made. Turning to the cited portion of Wiens at column 7, lines 28-47, which the Examiner contends "teaches communicating computer code" to a user's computer from the remote vendor, that code containing "pertinent vendor information", it is respectfully submitted that the cited portion does not in fact teach the missing limitation of communicating determination code to the user's computer for determining if a merchant website is a supported website. The information communicated to the user computer in the cited Wiens passage refers to the transmission of vendor information files that are sent to the customer computer in the event that the "version numbers of the one or more current versions of the corresponding vendor information files resident in the central vendor computer" do not match. Continuing on to column 7, lines 41-46, Wiens states that:

If the version numbers of the one or more vendor identification files sent by the customer computer do not match the version number resident in the central vendor computer, at step 44 the central vendor computer downloads to the customer the current versions of the one or more files whose version numbers do not match the current resident versions.

Thus, as can be readily seen by the above cited portion of Wiens, the communication between the vendor and the user's computer is for the purpose of determining whether or not the files resident on the user's computer, which facilitate the pre-ordering process prior to establishing a communication session, are up-to-date. Nothing in Wiens contemplates communication of determination code to the user's computer for determining if a merchant website is a supported website. Specifically, no such determination code is necessary or contemplated since the user knows which vendor computer to communicate with as a result of the vendor software installed being on a user's computer. Thus the hypothetical three-reference combination proposed by the Examiner cannot form a proper §103 combination, since all of the claimed limitations of the above-cited claims are not met by the three-reference combination.

The combination lacks the determination code limitation as claimed. Thus, it is respectfully submitted that the rejections to claims 1-14, 16-21, 23, 24, and 59 should be withdrawn and an indication of allowance of these claims be issued.

Further, in light of the above description of the Wiens system, it is respectfully submitted that rather than any motivation existing for the Examiner's hypothetical three-reference combination, the Wiens reference would in fact teach away from such a combination. Specifically, since it is conceded that O'Leary and Sidles both fail to explicitly teach communicating determination code to the user's computer for determining if a merchant website is a supported website, one skilled in the art would not look to Wiens for a solution since Wiens teaches a dedicated relationship between the user's computer, the software thereon, and the vendor's computer. Thus in the Wiens system no determination of a supported merchant need be made since the user already knows which vendor it intends to connect to, because the user is utilizing the vendor's custom software to enter order information prior to establishing a dedicated communication session with that vendor. Thus, one would not look to Wiens to cure the conceded deficiency, rather one would be taught away from

determination computer code since the Wiens reference teaches a dedicated relationship whereby the merchant identity is known in advance of establishing a session. Thus for this additional reason claims 1-14, 16-21, 23, 24 and 59 should be deemed patentable over the hypothetical three-reference combination, and notification of allowance is earnestly requested.

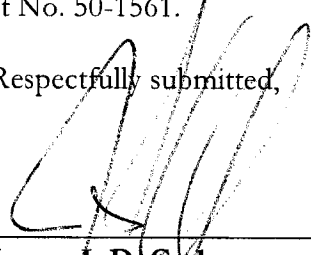
In the Office Action, claim 60 is identified as being rejected over the same three-reference combination, although, at page 8, the recitation with respect to claim 60 mentions only O'Leary and Sidles. Thus, it is unclear to the undersigned whether or not the Wiens reference has been utilized in rejecting claim 60 under 35 U.S.C. §103. It is respectfully submitted that if in fact the Wiens reference was utilized in connection with claim 60, then the arguments above with respect to the aforementioned claims applies equally here, and thus the rejection under 35 U.S.C. §103 as to claim 60 should be withdrawn for the reasons presented above. If in fact the three-reference combination is not relied upon for claim 60, than the additional reasons below are hereby presented.

Claim 60 recites, *inter alia*, communicating computer code to add a shopping assistant button to a toolbar of the Internet browser, and, further, determining at the computer if a website to which the Internet browser is caused to navigate is a supported merchant website, and wherein said shopping assistant button further provides an indicator when the Internet browser is caused to navigate to a supported merchant website. The Examiner contends that O'Leary teaches adding a shopping assistant button to a toolbar. However, neither Sidles nor O'Leary teaches determining at the computer if a website to which the Internet browser is caused to navigate is a supported merchant website. The Examiner contends that O'Leary discloses "in paragraph 52 that the user can launch the wallet interface by selecting a wallet icon at the merchant's website. The wallet icon thus indicate that the merchant is supported". It is respectfully submitted that O'Leary does not in fact teach the claim element recited above, in that the presence of a wallet icon at a website is not a determination at the computer if a website to which Internet browser is caused to navigate is a

supported merchant website, as recited in the claim. Moreover, the Examiner has not indicated where in O'Leary and Sidles the other recited element of "wherein said shopping assistant button further provides an indicator when the Internet browser is caused to navigate to a supported merchant website." It is respectfully submitted that O'Leary and Sidles do not teach this limitation, nor does Wiens. Thus it is respectfully submitted that neither the two-reference O'Leary and Sidles combination, nor the three-reference O'Leary-Sidles-Wiens combination teaches all of the elements of claim 60. It is respectfully submitted that the rejection to claim 60 under 35 U.S.C. §103 is improper and should be withdrawn, and early notification of allowance is hereby requested.

Early and favorable reconsideration of the present application is respectfully requested. If the Examiner is not in a position to allow all claims, the Examiner is urged to call the undersigned at 212-801-6729. Any additional fees or charges required at this time and in connection with the present application may be charged to Deposit Account No. 50-1561.

Respectfully submitted,

  
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**James J. DeCarlo**  
Reg. No. 36,120

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Customer Number 32361  
GREENBERG TRAURIG, LLP  
MetLife Building  
200 Park Avenue  
New York, NY 10166  
Phone: (212) 801-9200  
Fax: (212) 801-6400  
E-mail: decarloj@gtlaw.com